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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,734	10/01/2003	Kevin H. Gardner	UTSD:1510-1	4912
23379	7590	06/07/2005	EXAMINER	
RICHARD ARON OSMAN SCIENCE AND TECHNOLOGY LAW GROUP 242 AVE VISTA DEL OCEANO SAN CLEMENTE, CA 92672			SWOPE, SHERIDAN	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/677,734

Applicant(s)

GARDNER ET AL.

Examiner

Sheridan L. Swope

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

RD

### DETAILED ACTION

Claims 1-15 are pending.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2, drawn to a method of changing the intermolecular binding of a PAS domain, classified in class 435, subclass 440.
- II. Claim 3, drawn to a method of changing the intramolecular binding of a PAS domain, classified in class 435, subclass 440.
- III. Claims 4, 9, and 14, in part, drawn to a method of changing the kinase activity of a PAS domain, classified in class 435, subclass 440.
- IV. Claims 4, 9, and 14, in part, drawn to a method of changing the kinase specificity of a PAS domain, classified in class 435, subclass 440.
- V. Claims 5, 10, and 15, in part, drawn to a method of changing the channel patency of a PAS domain, classified in class 435, subclass 440.
- VI. Claims 5, 10, and 15, in part, drawn to a method of changing the channel specificity of a PAS domain, classified in class 435, subclass 440.

For each of Inventions III-VI above, restriction to one or more of the following is also required under 35 USC 121 and 327. Therefore, election is required of one of Inventions I-VI and, if one of Inventions III-VI is elected, one of Inventions (A)-(F) and one of Inventions (G)-(H), as indicated.

If one of Inventions III-VI is elected, elect one of:

- (A.) PAG kinase PAS A

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- (B.) NPAS2 PAS A
- (C.) HIF2a PAS B
- (D.) HIF1a PASB
- (E.) ARNT PAS B
- (F.) HERG N-terminal PAS

If one of Inventions III-VI is elected, also elect one of:

- (G.) Host cell
- (H.) animal

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Also, product and process inventions are distinct if any of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, (2) that the product claimed can be used in a materially different process of using that product, or (3) that the product claimed can be made by another and materially different process (MPEP § 806.05(h)). These inventions are different or distinct for the following reasons.

Inventions I-VI are independent because the methods of Inventions I-VI comprise different steps, utilize different products and/or produce different results.

A search for more than one of Inventions I-VI would be a burden on the Office for the following reasons. Because the methods of Inventions I-VI comprise different steps, utilize different products, and/or produce different results, a search for one said invention would not

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encompass a search for any other invention and searching all of Inventions I-VI, or a subset thereof would be a burden on the Office.

These inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter. Furthermore, as explained above, searching more than one invention would be a burden on the Office. Therefore, restriction for examination purposes, as indicated, is proper.

Claims 1, 6-8, 11, 12, and 13 link Inventions I-VI. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, Claims 1, 6-8, 11, and 12. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claim is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.



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